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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

STULBERGER, CAS P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2132

DATE MAILED: 07/18/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,398

Applicant(s)

SPITZ, CHARLES F.

Examiner

Cas Stulberger

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5, 6, 10-17, 19, 20, 23-29, 31, 32, and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Application WO 00/57318 to Forde et al. in view of International Application WO 00/62220 to Brown et al.

In regards to claims 1-3, 15-17, 27-29, and 39, Forde discloses a computer-bases method of applying a set of digital business signing rules for the processing of electronic documents. The method verifies the identity of an authorized user using a predefined verification protocol. Then a set of privileges associated with said authorized user is determined (Forde: page 5, lines 7-11). This meets the limitation of "comparing information obtained thereby to the access control rules stored in said database to determine whether the authorized use is authorized to have the document signed." Next the digital signature is attached to the electronic document (Forde: page 5, line 14). This meets the limitation of "the signing system signs the document using authentication information unique to the signing system." Forde also discloses an exemplary list of authorized users and their associated privileges in Table 1 (Forde: Table1; page 10, line 2). This meets the limitation of "a database holding access control rules that identify documents authorized users are allowed to have electronically signed." However Forde doesn't teach parsing the document.

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Brown discloses a parser which parses the document to identify the portion to be signed by the signer (Brown: page 12, last paragraph).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of processing electronic documents as taught by Forde with the method of parsing a document as taught by Brown in order to identify the to-be-signed portion of the document (Brown: page 13, second paragraph).

In regards to claims 5, 19, and 31, Forde discloses that the digital signature is an encrypted hash. The encryption is based on a private encryption key corresponding to the authorized user. The private key is complementary to a public decryption key corresponding to the authorized user (Forde: page 23, claim 33). This meets the limitations of “wherein said user authentication information comprises a digital certificate, with corresponding public and private keys.”

In regards to claims 6, 20, and 32, Forde does not disclose the digital certificate comprising an X-509 certificate. Brown discloses that the digital certificate used is the ANSI X.509 standard (Brown: page 29, last line of the first paragraph).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of using the digital certificate as taught by Forde with the X-509 digital certificate as taught by Brown because the X-509 digital certificate is the ANSI standard (Brown: page 29, last line of the first paragraph).

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In regards to claim 10, Forde discloses that F. Smith is given request privilege to a maximum cost of \$5000 (Forde: page 11, lines 19-20). If F. Smith attempts to fill in an amount in the cost field of the document greater than \$5000 the received document data would be rejected (Forde: page 12, lines 5-7). This meets the limitation of "a document validation server capable of receiving document validation requests from a user requesting a signed document to be validated and determining whether the signed document is valid in response to the request."

In regards to claims 11, 12, 23, 24, 35 and 36, Forde discloses that a user, in this case the issuer, L. Carter, is verified. L. Carter inserts his smart card in to the purchasing intelligent device. L. Carter's smart card matches an authorized user from the user list and the purchasing intelligent device is made available by the server for use by L. Carter. His privileges are determined. L. Carter opens his electronic mailbox later and finds the electronic purchase order in his in-box (Forde: page 14, lines 19-29). This meets the limitations of "wherein after the document validation server signs the document, the signed document is electronically forwarded to the user so that the user can forward the signed document to the recipient."

In regards to claims 13, 14, 25, 26, 37, and 38, Forde discloses that after the digital signature is affixed to the purchase order using a private encryption key, the completed order is transferred to the appropriate vending server connected by network (Forde: page 15, lines 25-31). The vending user using the vending intelligent device can then open an electronic mailbox and find the completed purchase order (Forde: page 16, lines 1-10). This meets the limitations of

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“wherein after the document is signed, the signed document is automatically electronically forwarded or emailed to a recipient.”

3. Claims 4, 18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forde et al. in view of Brown et al. as applied to claims 1-3, 5, 6, 10-17, 19, 20, 23-29, 31, 32, and 35-39 above, and further in view of U.S. Patent Application Publication No. 2002/0078140 A1 to Kelly et al.

Forde however does not teach that the document is not parsed if the user is not authenticated. Kelly teaches that the method may also include the step of authenticating the user before parsing the file (Kelly: page 2, paragraph 0027).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the computer based method and system for applying a set of business signing rules for the processing of electronic documents as disclosed by Forde with the method of authenticating the user before parsing the document as disclosed by Kelly in order to ensure that the page is not edited by an unauthorized person (Kelly: page 2, paragraph 0027).

4. Claims 7-9, 21, 22, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forde et al in view of Brown et al, and in further view of Kelly et al. as applied to claims 1-3, 5, 6, 10-17, 19, 20, 23-29, 31, 32, and 35-39 above, and further in view of U.S. Patent No. 5,742,769 to Lee et al.

Forde however does not disclose using the user's email address for authentication by comparing it to the email address stored in the database. Lee discloses that the processor

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provides an input screen that requests the user's email address and password. These items of user-entered information are provided to a security application that authenticates the user-entered information based on the information stored in subscriber database (Lee: column 5, lines 10-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the computer based method and system for applying a set of business signing rules for the processing of electronic documents as disclosed by Forde with the method of authentication using the comparison of user-entered information with that stored in a database as disclosed by Lee in order to provide users with additional services that are preferably not otherwise available to a user who accesses the web site without authentication (Lee: column 4, lines 59-62).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,314,425 B1 to Serbinis et al.

U.S. Patent No. 5,787,175 to Carter

U.S. Patent No. 5,315,504 to Lemble

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cas Stulberger whose telephone number is (703) 305-8034. The examiner can normally be reached on Monday - Thursday, 7:30A.M. - 5:00P.M.

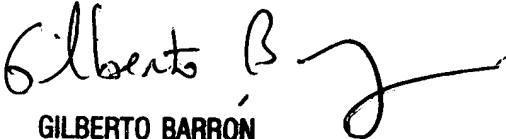
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

CS

CS
July 10, 2003


GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100